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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,333	09/18/2000	Goran Nilsson	3491-42	3777

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EXAMINER
LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/663,333	NILSSON ET AL.	
	Examiner	Art Unit	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/27/03* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Response to Amendment

In view of the Appeal Brief filed on 6/27/03, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1 .111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final; or, (2) request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1 .131 or 1 .132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1 Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the transfer of said tissue web from said shoe press nip directly to the yankee cylinder" in lines 14-15. There is insufficient antecedent basis for this limitation in the claim. Claim 1 at lines 3-4 provides proper antecedent basis for the limitation of "the transfer of said tissue web from said shoe press nip to the yankee cylinder" without the additional term "directly". It is suggest to insert the term - - directly-

- at line 3 of claim 1 after the term "from the shoe press nip" in order to provide proper antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2 Claims 1-6 and 8 rejected under 35 U.S.C. 103(a) as unpatentable over Applicant's Admitted Priot Art Teaching (PAT) in the preamble of Jepson claim 1 in view of Eklund et al (US 5298124). PAT disclose a soft tissue paper machine as set forth in the preamble but fails to disclose the specific claimed transfer belt. However, Eklund provides a transfer belt having the claimed properties. Eklund's claim 1 discloses a paper web transfer belt for the use in a paper machine having a supporting base and a top melted layer containing polymer and or a filler particle. The top melted layer having an air permeability less than 6 $m^3/m^2/min$, a resettable surface roughness in the range of R_z = 2 - 80μM, polymer coating hardness in the range of Shore A 50 to Shore A 97, and the filler contained in the polymer layer having a hardness different from that of polymer coating. A roughness of R_z= 0 – 20 when the polymer layer is compressed by a linear load of 20kN/m – 200kN/m is applied to the transfer belt (Column 16 lines 52-57). The air permeability of the belt was measured according to "Standard Test

Method for Air Permeability of Textile Fabrics", ASTM D737-75 (Column 8 lines 15-18). The filler comprising the belt may be kaolin clay (Claim 21). The polymer coating may be a polyurethane/polycarbonate resin composition (Claim 28). Eklund also discloses that the carrier (woven base) may be woven to produce an endless transfer belt once installed in a paper machine (Column 13 lines 23-36). Eklund also discloses in the abstract that the transfer belt can readily release the paper web due to its recovered uncompressed roughness property onto a dryer fabric where it then may be transfer to a dryer cylinder (Bridging Paragraph of Columns 5-6). Eklund's elements 7- 8, 29-30 and 46-47 in figures 1-3 disclose the belt being used in a press nip.

As shown above Eklund et al disclose the claimed improved transfer belt. As shown in applicant's Jepson claim, the admitted prior art provides for "a transfer belt for conduction a soft tissue web through a shoe press... a transfer nip transferring the soft tissue web from the transfer belt to the Yankee cylinder". In view that Eklund provides readily releasable properties to easily transfer a paper with minimum assistance and provides contributions over the prior art transfer belts (see col. 6 lines 1-19), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have substituted a conventional transfer belt of PAT with Eklund's transfer belt in order to take advantage of Eklund's properties. Furthermore, it is held that substituting a conventional transfer belt with another transfer belt such as Eklund, which discloses improved properties over the prior art, would have been obvious modification to one of ordinary skill in the art.

As for claim 5, the polymer layer encloses a portion of the carrier as shown in figure 4.

Response to Arguments

The nonstatutory double patenting rejection is based on a judicially created

Applicant's arguments with respect to claims 1-6 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,340,413 ('413). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of '413 provides a an endless embossed transfer belt having the claimed properties of Applicant's claim 1, forming an extended transfer nip with a yankee cylinder. The scope of the terms "essentially impermeable" and "polymer layer", recited in claim 13, encompass Applicant's limitations of claims 2-4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Sept. 13, 2003

STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700